

REMARKS

Applicant has amended claims 1, 4, 5, 6, and 9. Applicant has canceled claims 2 and 3.

Please note that Applicant has amended claim 9 to depend from claim 1. Because claim 9 now includes all of the limitations of claim 1, Applicant respectfully requests that claim 9 be included in elected Group I.

Applicant thanks Examiner Qian for the courtesies extended during the telephone inquiry on January 15, 2010 with the Applicant's attorney, Nanda Kumar, regarding clarification on the restriction requirement. The Examiner indicated that if Group XXI (claims 11, 23 and 24) is elected, Applicant must also elect single polypeptide (SEQ ID NO) for further Examination of the application. Election of Group I (claims 1-8) does not require further election of specific nucleic acid/protein, and claims 1-8 will be fully examined.

Applicant respectfully traverses the restriction requirement. The basis for the requirement to elect one of the 22 groups of invention appears to be that the inventions are not so linked as to form a single general inventive concept under PCT Rule 13.1. The Examiner contends that this is so because, under PCT Rule 13.2, they lack the same or corresponding special technical feature that is contribution over the prior art. The Examiner states that the "special technical feature of Group I is a regulatory biomolecule being a nucleic acid binding molecule or an allosterically controlled ribonucleic acid molecule, and a interaction partner encoded by a nucleic acid molecule, expressed both in a cell. The Examiner points to Toby et al., 2001, Methods (Orlando), 24:201-217 as disclosing the Examiner characterized special technical feature

As a preliminary matter, Applicant respectfully submits that during the international proceedings of the above National Stage application, the Examining Division has already found that claims 1-22 fulfill the Unity of Invention requirement under PCT Rule 13.2.

Notwithstanding, Applicant submits that the Toby is not prior art for this reference does not teach or suggest a method for monitoring the expression level of a gene in a host cell as claimed. Toby concerns the yeast-two-hybrid method, which is used to detect protein-protein interactions.

According to the prior art yeast-two-hybrid system, the strength of the interaction

between bait and prey defines the readout obtained with the reporter system. In contrast, the Tip-tag system presented in Applicant's invention is used to detect a protein amount. It uses a defined and constant interaction between the peptide (Tip) and the regulatory biomolecule (TetR) to monitor the amount of a protein tagged with the Tip peptide. The amount of the tagged protein in the cell determines the readout obtained with the reporter system.

Further, the expression "special technical features" is defined as "those technical features that define a contribution which each of the claimed inventions, considered as a whole, makes over the prior art." PCT Rule 13.2. Applicant respectfully submits that the each of the claimed inventions recite a number of special technical features. For example claim 1, in Group I, recites steps (a) and (b) which must be considered as a whole. Step (b) requires "assessing the expression level of the gene . . ." The Examiner has not shown where Toby teaches these special technical features. Mere conclusory allegations by the Examiner that "this special technical feature is shown by Toby et al. . . ." is not believed sufficient to support the required restriction.

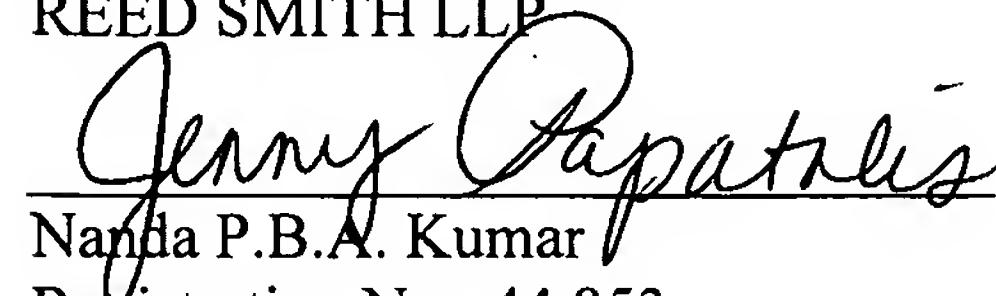
Applicant respectfully submits that the subject matter of the pending claims 1-24 are sufficiently related so that a thorough search for the subject matter of one group of claim(s) would necessarily encompass a search for the other groups of claims. In addition, the PCT examining division has already searched prior art with respect to these claims in the corresponding PCT application. Thus, Applicant respectfully submits that all the claims can be searched and examined without any serious burden to the Examiner.

It is further submitted that in view of the fees charged for filing of divisional patent applications, and prosecution and maintaining the resulting patents place an undue burden on the Applicant, which justifies that any restriction or election requirement be clearly supported and made according to the patent examining procedure.

Based upon the above remarks, Applicant respectfully requests reconsideration of this restriction requirement and early allowance of the pending claims. Should the Examiner feel that a telephone conference with Applicants' attorney would expedite prosecution of this application, the Examiner is urged to contact the undersigned attorney.

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Respectfully submitted,
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